

REMARKS

The Office Action mailed April 27, 2007, has been received and reviewed. Claims 1 through 59 are currently pending in the application. Claims 12, 15 through 23, 38 through 42, 49 and 58 are withdrawn from consideration. Claims 1 through 11, 13, 14, 24 through 37, 43 through 48, 50 through 57 and 59 stand rejected. Applicant has amended claims 1 and 28, and respectfully requests reconsideration of the application as amended herein. Applicant notes that withdrawn claims 12, 15 through 23, 38 through 42, 49 and 58 would be allowable upon allowance of claims under prosecution from which the withdrawn claims respectively depend.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 3,991,446 to Mooney et al.

Claims 1 through 11, 13, 14, and 24 through 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mooney et al. (U.S. Patent No. 3,991,446). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to claim 1, Applicant respectfully notes that the Mooney et al. reference fails to expressly or inherently describe several claim elements. For example, as is clear from the specification and drawings, circular head section 14 of the plug device 10, which the Office is apparently likening to Applicant's claimed "base" is not *sized and configured to fit within . . . a bore of a tubular member* (emphasis added). As is evident from drawing FIGS. 3 and 4 of the reference, head section 14 must be larger than any opening to be closed by plug device 10, as plug device 10 is secured in place between head section 14 and flat shoulders 22 of locking sections 17 of plug device 10.

Further, the reference fails to describe "at least one engagement feature protruding from the at least one movable structure and sized and configured to cooperatively engage *an*

associated wall structure of a side wall of the tubular member from within the bore thereof (emphasis added). As can be seen from FIG. 3 of the reference, the plug device 10 may serve to close a hole in a wall 12, which is not a “tubular member.” With respect to FIG. 4, Applicant respectfully noted that locking sections 17 do not engage any wall structure of a side wall of pipe or conduit 25, but contact a peripheral lip or flange 26 at the *end* of the pipe or conduit 25. To further emphasize this distinction, Applicants have amended claim 1 to recite that the recited engagement of the at least one engagement feature with the associated wall structure takes place *at a location longitudinally spaced from the bore end*, which is clearly not the case with the assembly described by the reference.

Accordingly, claim 1 is not anticipated by the reference and the rejection should be withdrawn.

Claims 2-11 are allowable as depending from claim 1. Claim 10 is further allowable as the reference fails to describe at least one moveable structure “sized and configured to at least partially accept at least one of a person’s finger and thumb.” Claim 11 is further allowable as the reference fails to describe a moveable structure including “at least one out radial surface sized and configured to substantially conform to the bore of the tubular member.”

Claims 24-27 are allowable as depending from claim 1. Claim 25 is further allowable as the reference fails to describe a closure element “sized and configured to fit substantially within the bore of the tubular member” as the closure element of the reference would be inoperable if base 14 was located within the tubular member of FIG. 4. Claim 26 is likewise not anticipated, as the closure element of the reference cannot be said in any circumstances to fit “entirely” within the bore of the tubular member of FIG. 4.

Anticipation Rejection Based on U.S. Patent No. 3,623,622 to Sullivan

Claims 1 through 6, 10, 11, and 24 through 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sullivan (U.S. Patent No. 3,623,622). Applicant respectfully traverses this rejection, as hereinafter set forth.

With respect to claim 1, Applicant respectfully notes that, in the embodiment of FIG. 6 of the reference, base 33 does not fit within and substantially close a bore of a tubular member;

rather, it is merely a portion of cap lid 14 which *extends over* the *end* of tubular container 50, which is closed by lock disc 20 secured within cap lid 14, neither of which fit within the bore of tubular container 50. Further, there is no movable structure in the reference movable relative to base 33 and within a periphery thereof, as arm 24 (identified in FIG. 4) lies *outside* any periphery of base 33.

With respect to the embodiment of FIG. 8, the same problem exists, in that moveable structure 56 lies peripherally outside of base 47. In addition, it is noted that base 47 is annular in shape, having a central opening therethrough into which it appears cup-shaped member 33 is received. Thus, base 47 alone fails to close any bore of a tubular member.

Applicant further notes, respectfully, that the structure of the reference, in all of its various embodiments, comprises a safety locking closure wherein a cap lid is hinged and permanently connected to a cap base. In some embodiments, this closure assembly is snapped to the mouth of a container (for example, a container containing medication) and, thus, does not fit within and substantially close a bore of a tubular member, but fits over the end of the tubular member (container). In at least one embodiment, the cap base is extended to form the container 50 itself, and, thus, the cap assembly cannot be said to be received within itself, nor (as previously noted) does base 33 effect closure of the tubular member.

Accordingly, claim 1 is not anticipated by the reference and the rejection should be withdrawn.

Claims 2-6, 10 and 11 are allowable as depending from claim 1.

Claims 24-27 are allowable as depending from claim 1. Claims 25 and 26 are further allowable because the reference fails to expressly or inherently describe any structure corresponding to the elements of either of these claims. In short, the closure element as described in the reference does not and cannot be said to be sized and configured to fit within the bore of a tubular member being closed.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 3,913,774 to Vajtay in view of U.S. Patent No. 3,991,446 to Mooney et al.

Claims 28 through 37, 43 through 48, 50 through 57, and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vajtay (U.S. Patent No. 3,913,774) in view of Mooney et al. (U.S. Patent No. 3,991,446). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

It is respectfully asserted that the rejection of claims 28-37, 43-48, 50-57 and 59 is improper. As noted above with respect to claim 1, Mooney et al. fails to describe a base “sized and configured *to fit within* a substantially close a bore of a tubular member. Thus, the combination of Mooney et al. with Vajtay fails to teach or describe all of the claim limitations of claim 28.

Further, mere substitution of the closure element of Mooney et al. for that of Vajtay results in an inoperable assembly in which the plug device of Mooney would fall out of the end of the tubular container of Vajtay absent mere frictional engagement therewith, which Vajay criticizes at Col. 1, lines 21-25. Specifically, Vajtay employs perforations 14 in the sides 12 of

tubes 10 which would not be engaged by the locking sections 17 of Mooney et al., the locking sections 17 not being configured for engagement of a side wall structure of a tubular member but instead being configured to secure plug device 10 of Mooney et al in an opening in a wall 12 or to the end of a pipe or conduit 25 in conjunction with a base 14 which lies *outside of* the opening to be closed. In other words, not only does the base of Mooney et al. lie outside the end of any tubular member to be closed, but it must be so located to be operable. As noted, there is no structure on the plug device 10 of Mooney et al. which might be used to engage the perforations 14 of Vatjay. For Mooney to be operable in the context of Vatjay, the ends of the Vatjay containers would have to be provided with a lip or protrusion 26, as depicted in FIG. 4 of Mooney et al. Thus, there would be no reasonable expectation of success of the combination asserted by the Examiner.

In addition, it appears that the Examiner is employing impermissible hindsight to assemble the combination of Mooney et al. with Vatjay, based on Applicant's own disclosure and that, even then, an inoperable assembly would result absent further modifications to the asserted combination which would not be evident to one of ordinary skill in the art absent further reference to Applicant's disclosure.

Thus, claim 28 is not obvious in view of the applied combination of references, and the rejection should be withdrawn.

Claims 29-37, 43-48, 50-57 and 59 are allowable as depending from claim 28. Further, claims 32, 33, 37, 38, 43, 44, 46, 54, 55, 56 and 57 are each allowable as the applied combination of references fails to teach or suggest the limitations thereof.

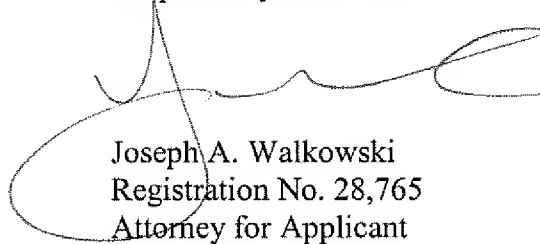
ENTRY OF AMENDMENTS

The amendments to claims 1, 28 and 46 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-59, including withdrawn claims 12, 15-23, 38-42, 49 and 58, are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Joseph A. Walkowski', is written over a circular stamp or seal.

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